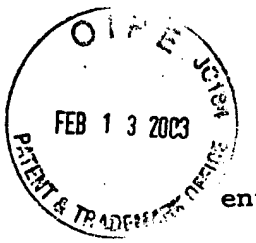

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 153

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Entered
2 April 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID E. CHARLTON,

Junior Party,
(Application 08/465,675),

v.

ROBERT W. ROSENSTEIN,

Senior Party
(Patent 5,591,645
Reissue Application 09/167,028).

Patent Interference 104,148

Before: McKELVEY, Senior Administrative Patent Judge, and GARDNER-LANE and TIERNEY, Administrative Patent Judges.

GARDNER-LANE, Administrative Patent Judge.

FINAL DECISION

A. Introduction

This interference is before a merits panel for entry of a final decision.

The board has received CHARLTON'S SUBMISSION OF ARBITRATION AWARD, accompanied by a DECISION ON ARBITRATION PURSUANT TO 37 CFR 1.690 (Paper 152). According to the decision on arbitration, "priority of invention is awarded to Charlton, the junior party" (Paper 152, pages 15-16). We construe the arbitration award to hold that Charlton established priority vis-a-vis Rosenstein and therefore Rosenstein has lost on the issue of priority.

B. Discussion

The sole count in the interference at this time is Count 4 (Paper 130, page 2):

Count 4

A test device in accordance with claims 38, 40 or 42 of Charlton application 08/465,675, further provided that said first portion includes a reconstitutable conjugate, supported therein and mobilizable by transport thereby of the liquid sample,

or

a method in accordance with claims 39, 41 or 43 of Charlton application 08/465,675, further provided that said first portion includes a reconstitutable conjugate, supported therein and mobilizable by transport thereby of the liquid sample,

or

a test strip in accordance with claims 1 or 11 of Rosenstein patent 5,591,645, or claims 1 or 11 of Rosenstein application 09/167,028, further provided said tracer site includes a tracer supported thereon such that when liquid is added the tracer becomes mobile and is transported,

or

a method in accordance with claims 9 or 19 of Rosenstein patent 5,591,645 or claims 9 or 19 of Rosenstein application 09/167,028, further provided said tracer site includes a tracer supported thereon such that when liquid is added the tracer becomes mobile and is transported.

The claims of the parties are:

Charlton:	38-43
Rosenstein patent:	1-23
Rosenstein reissue application:	1-74

The claims of the parties which have been designated as corresponding to Count 4, and therefore are involved in the interference, are:

Charlton:	38-43
Rosenstein patent:	1-23
Rosenstein reissue application:	1-73

The claims of the parties which have been designated as not corresponding to Count 4, and therefore are not involved in the interference, are:

Charlton:	None
Rosenstein patent:	None
Rosenstein reissue application:	74

During the course of the interference, Rosenstein attempted to have Rosenstein reissue claim 74 designated as corresponding to a count, i.e., become involved in the interference. In

deciding preliminary motions, a motions panel held that Rosenstein reissue claim 74 was not patentable to Rosenstein (Paper 127, pages 100-101 and associated findings). Accordingly, Rosenstein reissue claim 74 has never been designated as corresponding to a count in this interference.

Rosenstein reissue claim 74, however, is involved in companion Interference 104,476, where it was designated as corresponding to the Count 1 of Interference 104,476 at the time it was declared. In accordance with a telephone conference call with counsel, the issue of whether reissue claim 74 is patentable to Rosenstein will be "transferred" to Interference 104,476, where it is involved in an interference within the meaning of 35 U.S.C. § 135(a). During the telephone conference call, counsel for Rosenstein indicated that it wished to preserve a right to seek judicial review of the board's holding of unpatentability of Rosenstein reissue claim 74. Accordingly, in Interference 104,476, a final order will be entered in due course (within one month) from which Rosenstein will be able to seek judicial review from the board's holding that Rosenstein claim 74 is not patentable to Rosenstein.

Also discussed during the telephone conference call was Rosenstein reissue claim 75. While not involved in this interference, Rosenstein reissue claim 75 has been considered in Interference 104,476. An order entering Rosenstein reissue claim 75 in the Rosenstein reissue application will be entered in Interference 104,476 in due course (within one month).

In this interference, Rosenstein patent claims 1-23 and Rosenstein reissue application claims 1-73 correspond to Count 4. Since Rosenstein has lost on the issue of priority with respect to Count 4, a judgment will be entered against Rosenstein with respect to the noted claims.

C. Order and Judgment

Upon consideration of the record, and for the reasons given, it is

ORDERED that judgment on priority as to Count 4 (Paper 130, page 2), the sole count in the interference, is awarded against senior party Robert W. Rosenstein.

FURTHER ORDERED that senior party Robert W. Rosenstein is not entitled to a patent containing claims 1-23 (corresponding to Count 4) of U.S. Patent 5,591,645, granted January 7, 1997, based on application 08/049,247, filed April 20, 1993.

FURTHER ORDERED that senior party Robert W. Rosenstein is not entitled to a patent containing claims 1-73 (corresponding to Count 4) of application 09/167,028, filed October 6, 1998, to reissue U.S. Patent 5,591,645 (mentioned above)

FURTHER ORDERED that a copy of this paper shall be made of record in files of (1) Charlton application 08/465,675, (2) Rosenstein U.S. Patent 5,591,645 and (3) Rosenstein application 09/167,028.

FURTHER ORDERED that if there is a settlement agreement which has not already been filed in the Patent and Trademark

Office, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

mck

FRED E. McKELVEY, Senior
Administrative Patent Judge

SALLY GARDNER-LANE
Administrative Patent Judge

MICHAEL P. TIERNEY
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

104,148
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